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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/032,676	02/27/98	BOGEN S	CYL98-01

021005 IM62/0419
HAMILTON BROOK SMITH AND REYNOLDS
TWO MILITIA DR
LEXINGTON MA 02421-4799

EXAMINER	
LE,L	
ART UNIT	**PAPER NUMBER**
1743	11

DATE MAILED: 04/19/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applic...(s)
09/032,676	Bogen et al.
Examiner	**Group Art Unit**
Long V. Le	1743

☒ Responsive to communication(s) filed on *Aug 13, 1999*

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *THREE* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) *1-17* is/are pending in the applicat

Of the above, claim(s) *14-17* is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-13* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims *14-17* are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *9 and 10*

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Election/Restriction

1. Newly submitted claims 14-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-13, drawn to a microscope slide stainer, classified in class 422, subclass 64.

II. Claims 14-17, drawn to a method for staining biologic samples, classified in class 436, subclass 46.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed in group II can be practiced by another and materially different apparatus such as an incubator for incubating disposable chemical slides.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for group I is not required for group II and vice versa, restriction for examination purposes as indicated is proper.

2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 14-17 have been withdrawn from

consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

5. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bogen et al. (USP 5,645,114) in view of Muller et al. (USP 5,273,905) or Potter et al. (USP 5,819,842).

Bogen et al. disclose an automatic device for incubating samples substantially as claimed. The device comprises a moving platform 510 for supporting a plurality of microscope slides bearing samples, a plurality of heating element sets 512a-512e positioned on the platform for providing heat to the samples (figures 6-8). Bogen et al. fail to specifically recite each of the heating element sets having the capability of heating to different temperatures.

Muller et al. teach a sample slide processing system having a plurality of heating element sets , each of which has the capability of heating to different temperatures (column 17, line 37 to column 18, line 37, column 29, lines 30-36). Such an independent temperature control of heaters would provide an improved slide analyzing system that can be operated and practiced so as to carry out a given multi-step slide processing sequence in a replicable manner (column 2, lines 22-66). Likewise, Potter et al. teach an apparatus for temperature control of multiple samples, wherein the temperature of each sample is controlled independently by individual heating element and temperature sensor 22 (figure 2), in order to greatly facilitate multi-user applications (Summary of the Invention).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the device of Bogen et al., with independent controlled heaters, as taught by Muller et al. or Potter et al., in order to an improved slide analyzing system that can be operated and practiced so as to carry out a given multi-step slide processing sequence in a replicable manner and to greatly facilitate multi-user applications.

With respect to the group of wires, it would have been an obvious matter of design choice to provide the device of Bogen et al. with a particular number of wires, since applicant has not disclosed that such a recited group of wires solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any particular group of wires depending on a particular heating application.

6. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muraishi (USP 5,154,889) in view of Muller et al. (USP 5,273,905) or Potter et al. (USP 5,819,842).

Muraishi discloses an automatic device for incubating samples substantially as claimed. The device comprises a platform for supporting a plurality of samples, a plurality of heaters 71 positioned on the platform for providing heat to the samples (figures 1 and 6, and column 6, lines 32-48). The moving platform is taught by Muraishi at figures 10 and 11. Muraishi fails to specifically recite each of the heating element sets having the capability of heating to different temperatures.

Muller et al. teach a sample slide processing system having a plurality of heating element sets, each of which has the capability of heating to different temperatures (column 17, line 37 to column 18, line 37, column 29, lines 30-36). Such an independent temperature control of heaters would provide an improved slide analyzing system that can be operated and practiced so as to carry out a given multi-step slide processing sequence in a replicable manner (column 2, lines 22-66). Likewise, Potter et al. teach an apparatus for temperature control of multiple samples, wherein the temperature of each sample is controlled independently by individual heating element and temperature sensor 22 (figure 2), in order to greatly facilitate multi-user applications (Summary of the Invention).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the device of Muraishi, with independent controlled heaters, as taught by Muller et al. or Potter et al., in order to an improved slide analyzing system that can be operated and practiced so as to carry out a given multi-step slide processing sequence in a replicable manner and to greatly facilitate multi-user applications.

With respect to the group of wires, it would have been an obvious matter of design choice to provide the device of Muraishi with a particular number of wires, since applicant has not disclosed that such a recited group of wires solves any stated problem or is for any particular purpose and it appears that the invention would

perform equally well with any particular group of wires depending on a particular heating application.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 09/205,945. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have recognized that the instant claims are encompassed by the claims of the copending Application No. 09/205,945.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

9. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. No claims are allowed.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Long V. Le whose telephone number is (703) 305-3399.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

Long V. Le
Primary Patent Examiner, Group Art Unit 1743
April 11, 2000.